

REMARKS

The allowability of claims 6 and 7 indicated by the absence of rejection is acknowledged appreciatively.

Nevertheless, claims 6 and 7 are combined to claim "... overlapped ends of ... rubber tube and ... inside and outside stent bodies ... held together with thread stitching and an impregnated polyurethane ..." simply as a structure in correspondence with the more precise product-by-process definition of this structure as impregnated stent body ends and thread in now-independent claim 5.

The rejection under 35 USC 103 of claim 5 requires the addition of the Lentz patent in respect to thread to Bynon, et al and Thompson patents that show adhesive or impregnated end-fastening but not thread, too. The prescription for this in the Action is:

The motivation for the combination of Boylan [sic., Bynon, et al.] and Thompson is to increase flexibility of the stent, which will make it easier for the operator to deliver the stent and for the stent to adapt to any size and shape that the surgery requires. The combination also provides the stent with shape memory characteristics, which also aid in delivery of the stent and the stents expansion to full [sic., fill] the operation site. All of the enhanced properties still allow the stent to be impermeable to undesired fluids. The motivation for further adding the sutures of Lentz to the combination are for further securing the stent stands [sic., ends?] to the conduit. The sutures prevent strands from unwinding and separation

but this is a description of hindsight reconstruction, which is improper, and not motivation in the references for their combination as claimed.

There are only three possible sources of the motivation necessary to combine references, "... the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 47 USPQ2d 1453 (Fed.Cir. 1998). Nothing said in the Action notes a problem with the art, a teaching of the art or skill in the art to motivate combining these references, and not others, piecemeal into the

combination claimed.

Nothing is not a basis for rejection.

That features claimed may be in the art makes no difference.

That features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover most if not all elements perform their ordained and expected function. Connell et al. v. Sears, Roebuck & Co., 220 USPQ 193, 199 (Fed. Cir. 1983).

In this case, for example, that the stitches of the Lentz patent "... are for further securing the stent stands [sic., ends?] to the conduit ...," is an expected function and not a motivation as necessary for combination into a rejection.

In order for one to defeat a meritorious patent it is not enough to pick out isolated features in earlier prior art patents, combine them in one particular way with hindsight acquired only from the patent under attack, and then say that no invention would have been involved in selecting those particular features and combining them in the particular way in which the patentee did. Eversharp, Inc. et al. v. Fisher Pen Co., Inc. et al., 132 USPQ 423 (N.D.D.C. Ill. 1961).

The claimed invention has a net-like stent structure with a third layer not shown for net-like stent structures in the references (cf., Figs. 1 and 2, 4 of Bynon, et al.) and such more-layered net would not seem teach those of ordinary skill more flexibility, as indicated in the Action.

Most importantly, however, the Lentz patent discloses as cited from column 4 "... cuffs ... of separate, distinct portions of synthetic material ... glued or sutured onto tubular conduit ... [stent]." Claim 7 requires stitching and impregnated polyurethane, not or, and not separate cuffs, but only the ends of the rest of the stent and tube structure. Claim 5 requires the same, and more, as a "single structure" from immersion in polyurethane after being sewn.

Therefore, the references fail to reconstruct the claimed invention even if such reconstruction were proper, which it is not.

Reconsideration and allowance are, for these reasons, requested.

Respectfully submitted,

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